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REMARKS

Claims 1-2, 4-10, and 13-27 are pending in this application.

The applicants thank the Examiner for accepting the drawings and for acknowledging the claim for foreign priority, and that certified copies of the priority document have been received.

The applicants are confused by the Examiner's response to the applicants' prior remarks. In the prior Office action, and again in this Office action, the Office action states: "it is noted that the features upon which the applicant relies (*i.e. selectively*) are **not recited in the claims** [1 and 14]" (final Office action, page 2, last two lines).

Claim 1 specifically recites: "a gatekeeper device that is configured to ***selectively*** transmit", and claim 14 specifically recites: "***selectively*** communicating a user identification". Thus, it is clear that the feature upon which the applicants rely (*i.e. selectively*) is obviously recited in the claims.

The applicants respectfully request withdrawal of the finality of this Office action, due to the erroneous and/or non-responsive nature of the response to the applicants' prior arguments.

The Office action rejects claims 1 and 14 under 35 U.S.C. 102(b) over Duhane et al. (USP 5,541,585, hereinafter Duhane). The applicants respectfully traverse this rejection.

The Examiner's attention is requested to the applicants' prior remarks, and again requested to to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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As noted above, claim 1 claims a system that includes "a gatekeeper device that is configured to ***selectively*** transmit a user identification only, in response to receipt of a communication from the apparatus".

Duhane does not teach a gatekeeper device that is configured to ***selectively*** transmit a user identification in response to receipt of a communication from an apparatus. Duhane teaches a gatekeeper device that ***automatically*** transmits a user identification in response to receipt of a communication from the apparatus. The applicants respectfully maintain that an automatic response is not equivalent to a selective response.

Because Duhane does not teach a device that ***selectively*** transmit a user identification in response to receipt of a communication from an apparatus, as specifically claimed in claims 1 and 14, the applicants respectfully maintain that claims 1 and 14 are patentable under 35 U.S.C. 102(b) over Duhane.

The Office action rejects claims 2, 4, 6, 10, and 15-16 under 35 U.S.C. 103(a) over Duhane and Brinkmeyer et al. (USP 5,983,347, hereinafter Brinkmeyer). The applicants respectfully traverse this rejection.

The Office action relies upon Duhane for teaching the elements of claim 1 and 14, upon which each of these rejected claims depend. As noted above, Duhane does not teach the elements of claims 1 and 14, and thus the applicants respectfully maintain that this rejection is unfounded.

Further, assuming in argument that Duhane and Brinkmeyer teach the elements of the rejected claims, the applicants respectfully maintain that there is no suggestion in the prior art to combine Duhane and Brinkmeyer, because Duhane specifically teaches against the teachings of Brinkmeyer, and because Brinkmeyer specifically teaches against Duhane.

The Examiner's attention is requested to MPEP 2143, wherein it is stated:

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)".

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Duhane teaches a remote device that operates independent of user interaction, and Brinkmeyer teaches a remote device that requires user interaction. The applicants respectfully maintain that these are contradictory teachings that cannot be resolved by any of the teachings in the prior art, and thus cannot be said to suggest the desirability of the proposed combination.

Duhane specifically teaches against a remote device that requires user intervention:

"However, to unlock the door, hand-held transmitters still require the person seeking access to set aside some or all of the items they are carrying, locate the transmitter in, for example, their purse or pocket, and press the appropriate button on the transmitter. These hand-held transmitters therefore suffer many of the same problems as conventional keys. Unlocking doors by turning door knobs in a pre-prescribed manner also suffer many of these same problems." (Duhane, column 1, lines 33-41.)

Brinkmeyer specifically teaches against remote devices that do not require user interaction:

"All of these conventional authentication devices have in common the fact that the electronic authentication communication proceeds automatically as far as the key element is concerned and hence unnoticed and uninfluenced by the user. This results in the following theoretical weaknesses in this system as far as protection against manipulation is concerned." (Brinkmeyer, column 2, lines 21-27.)

Further, MPEP 2143, also states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

The applicants respectfully maintain that the proposed combination of Duhane and Brinkmeyer will render the proposed combination unsuitable for its intended function. The applicants respectfully maintain that a combination of the contradictory teachings of Duhane and Brinkmeyer would require application of the teachings of one, to the exclusion of the other. In either event, the intended function of *selectively* transmitting will not be achieved.

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Because Duhane and Brinkmeyer do not teach each of the elements of the applicants' claims, and/or because each of Duhane and Brinkmeyer teach against each other, and thus there is no suggestion to combine these references, and/or because a combination of the contradictory teachings of Duhane and Brinkmeyer will not provide the intended function, the applicants respectfully maintain that the rejection of claims 2, 4, 6, 10, and 15-16 under 35 U.S.C. 103(a) over Duhane and Brinkmeyer is unfounded.

The Office action rejects claim 5 under 35 U.S.C. 103(a) over Duhamé, Brinkmeyer, and Kushiro et al. (USP 6,285,357, hereinafter Kushiro). The applicants respectfully traverse this rejection, based on the remarks above regarding Duhamé and Brinkmeyer and claim 4, upon which claim 5 depends.

The Office action rejects claims 8, 9, 13, 17, and 18 under 35 U.S.C. 103(a) over Duhamé and Nickum (USP 6,359,661). The applicants respectfully traverse this rejection.

Claim 13 is dependent upon claim 1, and claim 17 is dependent upon claim 14, each of which are discussed above with regard to Duhane.

The Office action relies upon the asserted equivalence of the elements of claim 1 and the teachings of Duhamé to support the asserted teaching by Duhane of the corresponding elements of claim 8, upon which claims 9 and 18 depend.

Claim 8 specifically claims "a gatekeeper device that is configured to selectively transmit a user identification, in response to receipt of a communication from the apparatus".

As noted above, Duhamé teaches *automatically* transmitting a user identification, and does not teach *selectively* transmitting a user identification, as specifically claimed in claims 1, 8, and 14, upon which each of the dependent claims depend.

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The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*." ...
If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Because the combination of Duhamel and Nickum fail to teach all of the claim limitations of the independent claims 1, 8, and 14, the applicants respectfully maintain that the rejection of claims 8, 9, 13, 17, and 18 under 35 U.S.C. 103(a) over Duhamel and Nickum is unfounded.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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